

REMARKS

In the Office Action, claims 1-52 were rejected by the Examiner. More particularly, claims 1-52 were rejected for double patenting, claims 1-50 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter, claims 2, 16-24, 27, 29, 30, 35, 39, 42, 43, and 50 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite, claims 1, 5, 6, 8, 10, 11, 14, 15, 22-24, 28-31, 39-41, and 44-50 were rejected under 35 U.S.C. § 102(b) as anticipated by “Wisconsin Business, Insurers Take New Look at Wellness Programs” (“Wallenfang”), claims 2-4, 7, 9, 12, 13, 16-21, 25-27, 32-38, 42, and 43 were rejected under 35 U.S.C. § 103(a) as obvious over Wallenfang in view of various other references, and claims 51 and 52 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Number 6,454,705 (“Cosentino”) in view of Wallenfang.

Upon entry of this Response, claims 1-4 and 6-53 will be pending. Claims 1, 2, 8, 9, 16, 18-23, 29, 35, 39, 40, 42, 43, 46, and 51 have been amended. Claim 5 has been cancelled. For the reasons set forth below, Applicant requests that the above-listed objections and rejections be withdrawn.

Objections to the Claims

The Examiner objected to claim 46 for use of the term “identifying.” Applicant has revised the term to “identifies” in accordance with the Examiner’s recommendation, and therefore requests withdrawal of this objection.

Double-Patenting Rejections

The Examiner provisionally rejected claims 1-51 under 35 U.S.C. § 101 for claiming the identical invention as that of claims 1-50 and 55 of copending application number 11/055,496. Applicant has canceled claims 1-50 and 55 of copending application number 11/055,496 in a Response filed on this same day, and therefore submits that the rejection of these claims is moot.

The Examiner provisionally rejected claim 52 on the ground of nonstatutory obviousness-type double patenting over claim 54 of copending application number 11/055,496. Applicant respectfully submits that upon allowance of the pending claims, Applicant will submit a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c).

Rejections under 35 U.S.C. § 101

The Examiner rejected claims 1-50 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant submits that claims 1-50 are transformative under *In re Abele* 684 F.2d 902 (CCPA 1982), cited favorably by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). In *In re Abele*, the court found that processing cat scan data and displaying the processed data in a particular way would satisfy the “transformation” requirement. *Id.* at 906. Similarly, claims 1-50 process “health risks, the biometric measurement analysis, or the one or more biometric parameters” and create a Health Score from the data. The one or more participants of the health care program are then notified of this Health Score.

Rejections under 35 U.S.C. § 112

The Examiner rejected claims 42 and 43 under 35 U.S.C. § 112, second paragraph, for using “means” language without disclosing corresponding structure in the written description. Applicant has revised claims 42 and 43 to eliminate any means plus function limitations, and therefore requests withdrawal of these rejections.

The Examiner rejected claims 2, 16-21, 18-24, 27, 29, 30, 35, 39, 42, 43, and 50 under 35 U.S.C. § 112, second paragraph, as indefinite for various reasons. Applicant has amended these claims to ameliorate the errors identified by the Examiner, and therefore requests reconsideration and withdrawal of these rejections

The Examiner rejected claims 1 and 9 under 35 U.S.C. § 112, second paragraph, as indefinite for using claim terms without antecedent basis. With respect to claim 1, Applicant submits that “the biometric measurement analysis” in line 9 refers back to “a biometric measurement analysis” in line 7, and that there is sufficient antecedent basis for this claim term. With respect to claim 9, Applicant has removed the “the future” limitation. Applicant therefore requests reconsideration and withdrawal of these rejections.

Rejections under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 1, 6, 8, 10, 11, 14, 15, 22-24, 28-31, 39-41, and 44-50 under 35 U.S.C. § 102(b) as anticipated by Wallenfang, claims 2-4, 7, 9, 12, 13, 16-21, 25-27, 32-38, 42, and 43 under 35 U.S.C. § 103 as obvious over Wallenfang in view of various other

references, and claims 51 and 52 under 35 U.S.C. § 103(a) as obvious over Cosentino in view of Wallenfang.. Applicant traverses this rejection.

Applicant has revised independent claims 1 and 51 to incorporate some of the limitations of claim 8, namely requiring that the “incentive program provides for an incentive for at least one of achieving a predetermined Health Score or improving a Health Score.” Applicant submits that no reference cited by the Examiner discloses this limitation.

Wallenfang discloses the calculation of a “wellness score”. (Wallenfang at 3). Wallenfang also discloses the provision of various incentives for, for instance, participating in a wellness program. (Wallenfang at 2). Wallenfang nowhere discloses the provision of incentives for achieving a predetermined Health Score or for improving a Health Score. Even presuming for the purposes of this Response that the wellness score of Wallenfang qualifies as a “Health Score,” Wallenfang simply does not utilize the wellness score in the manner required by these claims. The only use to which Wallenfang puts the wellness score is to correlate the wellness score to annual medical costs. (Wallenfang at 4). Wallenfang does not teach or even suggest providing an incentive for achieving a predetermined wellness score or for improving a wellness score.

Applicant has also revised claim 40 to affirmatively require that “the step of completing the health risk assessment questionnaire or the biometric measurement analysis or providing the biosample for biomedical analysis” be used for “categorizing the participant under assessment for purposes of enrollment in a clinical trial, on the basis of the health risks results, the biometric parameters results, or biomedical results.” Applicant submits that no reference cited by the Examiner discloses this limitation.

For the reasons cited above, and because the other references cited by the Examiner do not remedy the above-referenced deficiencies of Wallenfang, Applicant submits that claims 1, 40, and 51 are allowable over Wallenfang. Claims 2-4, 6-49, and 52 are believed allowable at least by virtue of their dependence from claims 1 or 51. Applicant respectfully requests the reconsideration and withdrawal of the rejections of claims 1-4 and 6-52.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and

withdraw all presently outstanding objections and rejections. There being no other rejections, Applicant respectfully requests that the current application be allowed and passed to issue.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this Response, or credit any overpayment, to deposit account no. 13-0019.

Respectfully submitted,

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